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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,125	06/12/2000	ANIL N. SHETTY	287300023POA	2994

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EXAMINER

SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/486,125

Applicant(s)

SHETTY ET AL.

Examiner

Ruth S Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-37 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 7, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 19, 20, 22,23,24,29,30,35,36 are rejected under 35 U.S.C. 102(e) as being anticipated by Damadian. The claims are directly readable on Damadian which includes using a first set of parameters to image at a first location using MRI and then based upon the next predicted location of the contrast agent loading a second set of parameters to image the second location using MRI. The claims fail to set forth that the step are required to be performed in the order as set forth.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20, 22,23,24,29,30,35,36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over applicant's admission of the prior art. The claims are directly readable on the use of a conventional MRI system to perform two different scans on a patient as is old and well known in the art. The time it takes to set up for a second scan would inherently provide the patient enough time to breathe and hold the breath again. The claims fail to set forth that the steps are required to be performed in the order as set forth. However, if one interprets the claims as requiring the steps to be performed in the specific order set forth, it would have been obvious to one skilled in the art to have entered all scan parameters before performing the scans in order to expedite the scanning process and reduce the patient's time in the bore of the magnet.

Claims 19, 20, 22,23,24,29,30,35,36 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hurd et al. The claims are directly readable on Hurd et al which disclose acquiring imaging data using a first set of parameters and then acquiring image data using a second set of parameters. After the scan is completed the image data acquired from each set of parameters is processed. The claims fail to set forth that the steps are required to be performed in the order as set forth. However, if one interprets the claims as requiring the steps to be performed in the specific order set forth, it would have been obvious to one skilled in the art to have entered all scan parameters before performing the scans in order to expedite the scanning process and reduce the patient's time in the bore of the magnet.

Claims 26-28, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurd et al or Damadian in view of Riederer et al. Hurd et al disclose acquiring

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imaging data using a first set of parameters and then acquiring image data using a second set of parameters. After the scan is completed the image data acquired from each set of parameters is processed. Damadian discloses using a first set of parameters to image at a first location using MRI and then based upon the next predicted location of the contrast agent loading a second set of parameters to image the second location using MRI. Riederer et al disclose an MRI system which includes a stimulus for prompting a patient when they can breathe. The stimulus can be audible or visual. It would have been obvious to one skilled in the art to have modified either Hurd et al or Damadian such that it includes a means for indicating to a patient when they can breathe in order to allow the patient to have some form of indicator which shows how much longer they must stay still.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's own admission or Damadian or Hurd et al alone or further in view of Matsutani. Applicant, Damadian and Hurd et al each disclose all of the claimed invention to be old but fails to specifically refer to the use of a drive device to move the patient. It is old and well known in the art to move a patient on an examination table in order to correctly position them for the next desired scan. Matsutani et al is merely one example of such. It would have been obvious to one skilled in the art to have modified the prior art system disclosed by Applicant, Damadian or Hurd et al such that it includes a drive device to move the examination table for a second scan in order to correctly position the patient as is a well known expedient in the art.

Claims 25, 31, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's own admission or Damadian or Hurd et al. Applicant, Damadian and Hurd et al each disclose all of the claimed invention to be old but fails to specifically set forth the delay time. In the absence of any showing of criticality or unexpected results the delay time selected would have been obvious selection based upon the time it takes to move the patient to a second scan position.

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***R s p o n s   t o   A r g u m   n t s***

Applicant's arguments filed January 7, 2002 have been fully considered but they are not persuasive. The claims fail to positively set forth that the steps are required to be performed in the order set forth. Therefore, the claims can read on a system where the first scan parameters are loaded and then a first scan is conducted and then second scan parameters are loaded and then a second scan is performed. However, if one interprets the claims as requiring the steps to be performed in the specific order set forth, it would have been obvious to one skilled in the art to have entered all scan parameters before performing the scans in order to expedite the scanning process and reduce the patient's time in the bore of the magnet.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (703) 308-3256. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read 'R. Smith', with a stylized, cursive script.

Ruth S Smith  
Primary Examiner  
Art Unit 3737

RSS  
March 1, 2002